

## REMARKS

### I. Amendments

Claims 14 and 15 are amended. No new matter is introduced by the claim amendments. By this amendment, claims 1-17 remain in the instant application.

### II. Restriction

Applicant submits that Group VII (claim 17) should be rejoined with Group I. Claim 17 recites the preparation of claim 3, which preparation is an essential feature of the commercial package of claim 17. There should not be restriction between Groups I and VII (see MPEP §806.05(c) II).

Applicant submits that claims 14 and 15 (Groups IV and V, respectively) are properly dependent on claim 8 (Group II) since claims 14 and 15 recite additional steps. Claims 14 and 15 should be rejoined with Group II.

Applicant further submits that the subject matter of all the claims is sufficiently related that a thorough search for the subject matter of a single independent claim would necessarily encompass a search for the subject matter of the remaining claims. Thus, a search and examination of the entire application could be performed without serious burden. MPEP §803 clearly states that "If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions" (emphasis added). It is submitted that this policy should apply in the present application in order to avoid unnecessary delay and expense to Applicants in duplicative examination by the Patent Office.

With respect to the species election, the Examiner requires an election of cell source as well as mammals: (a) a delayed mammalian blastocyst, (b) an early post-implantation embryo together with its extra-embryonic tissues, (c) an embryonic stem cell-derived embryoid body, (d)

bone marrow tissue, (e) humans, and (f) all other mammals. Applicant traverses on the grounds that the search and examination of species (a) through (f) is not unduly burdensome. In particular, it is noted that the Examiner has failed to demonstrate that the species are classified in different classes or subclasses. Moreover, 37 C.F.R. 1.141 provides that a reasonable number of species may still be claimed in one application if the other conditions of the rule are met; *i.e.*, provided that the application also includes an allowable claim generic to all the claimed species and all the claims to species in excess of one are written in dependent form or otherwise include all of the limitations of the generic claim.

Applicant's claimed invention meets all of the requirements of 37 C.F.R. 1.141 and, therefore, the species election requirement for the listed cell sources and mammals should be withdrawn.

Finally, Applicant presumes that the Examiner will follow the procedures delineated in MPEP §809.02(c).

### **III. Conclusion**

The Examiner is respectfully requested to reconsider and withdraw the Restriction Requirement and to examine all the claims now pending in this application.


In accordance with this election with traverse, applicant reserves all rights in the non-elected claims, including the right to file one or more divisional applications covering the subject matter thereof.

If any questions or issues remain, the Examiner is invited to contact the undersigned at the telephone number set forth below so that a prompt disposition of this application can be achieved.

Respectfully submitted,

KLARQUIST SPARKMAN, LLP

By

  
David Cash, Ph.D.  
Registration No. 52,706

One World Trade Center, Suite 1600  
121 S.W. Salmon Street  
Portland, Oregon 97204  
Telephone: (503) 595-5300  
Facsimile: (503) 228-9446